

Remarks

Favorable reconsideration of the above-identified application in view of the present response is respectfully requested.

Applicants note with appreciation that claim 21 was indicated to be allowed in the Office Action.

By this paper, Applicants have amended claims 14 and 16, cancelled claim 15 and added new claim 43. Additionally, Applicants have amended the specification. Support for the amendments is found in the originally filed application. No new matter has been added by virtue of the present amendments. Claims 14 and 16-43 are now pending.

A. Claim Rejections Under 35 U.S.C. § 112

Claims 14-16, 22-24, 28-31, 35, 36, 41, and 42 have been rejected under 35 U.S.C. § 112, first paragraph. The Examiner states that the nature of the impregnable layer and the non-impregnable layer is "critical" for the invention to function as intended. Applicants respectfully traverse this rejection.

A claim rejection for failure to cite an essential limitation may only be made where the specification makes it clear that a limitation is critical for the invention to function as intended. That is clearly not the case here.

"In determining whether an unclaimed feature is critical, the entire disclosure must be considered." MPEP 2164.08(c). (Emphasis added.) Looking at the entire disclosure, there is no support for the proposition that porosity is a critical limitation for the impregnable layer. Similarly, there is no support for the proposition that it is critical that the non-impregnable layer comprise an elastomeric foam-type material.

The specification states clearly: “[t]he composite pad 20, as best shown in Figure 2, comprises an impregnable layer 30 and a non-impregnable layer 32.” *See*, Application, p. 5, ll. 3-5 (emphasis added).¹ The MPEP, at § 2164.08(c), clearly states that broad language that omits the alleged critical feature shows non-criticality. It is undisputable that the present application has such broad language. Subsequent descriptions of the nature of the layers are merely examples of preferred materials within the broader context of non-impregnable and impregnable materials. MPEP 2164.08(c) makes it clear that a § 112 rejection may not be made merely to limit an applicant to preferred materials in the absence of limiting prior art. No prior art rejections of these claims have been made here. As such, to limit them as suggested by the Examiner is clearly improper.

Claims 14-16, 22-24, 28-31, 35, 36, 41, and 42 are fully enabled. Contrary to Examiner’s position, the impregnable layer comprising a porous material and the non-impregnable layer comprising an elastomeric foam-type material are neither critical nor essential to the practice of the invention. Applicants respectfully request that Examiner withdraw the rejection and place the application in condition for allowance.

B. Claim Rejections Under 35 U.S.C. § 102

Claims 14 and 15 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,935,364 to Groendal *et al.* (*Groendal*).

A rejection under 35 U.S.C. § 102 is proper only if each and every element set forth in the claim is found in a single prior art reference. MPEP 2131. *Groendal* does not disclose every element of claim 14. For instance, *Groendal* does not disclose “a cover skin disposed over and bonded to the first surface of the substrate.” (Emphasis Added). Claim 14 states that the first surface of the substrate and the first surface of the non-impregnable layer face in the same general direction. In Figure 4, *Groendal* clearly shows the upholstery

¹ This broad disclosure is also found elsewhere throughout the application, including the originally filed claims (such as original claim 14) and the Abstract.

fabric 16 bonded to layer 20 along a surface that faces generally downward. The upholstery fabric 16 is bonded to a surface of the substrate 26 that faces in the opposite direction of layer 20. Because *Groendal* does not disclose every element of claim 14, the rejection is improper and must be withdrawn.

Claim 15 has been cancelled.

Claims 14, 36, and 42 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,593,848 to Landau (*Landau*). *Landau* does not disclose each and every element of claim 14.

First of all, *Landau* does not disclose a cover skin that is disposed over and bonded to a non-impregnable layer. The examiner appears to suggest that *Landau's* (i) clear coating film corresponds with the claimed cover skin, (ii) laminated film layer 36 corresponds with the claimed non-impregnable layer, and (iii) laminated foam layer 32 corresponds with the claimed impregnable layer. *Landau* clearly states, however, that the clear coating is applied to the foam in lieu of (which means instead of) a laminated film 36. (Column 4, lines 7-10). This "in lieu of" language precludes *Landau* from teaching the structure the Examiner asserts is taught in paragraph 6 of the Office Action. *Landau's* clear coat replaces the film layer 36 and at best, is bonded only to the foam layer 32. (Column 10, lines 10-14). Claim 8 of *Landau*, which depends from independent claim 6, clearly indicates that the clear coating (that is used in lieu of the laminated film) covers the plastic foam layer. As such, *Landau* clearly teaches a clear coat that is disposed over and bonded to an impregnable layer. Because *Landau* does not disclose a cover skin disposed over and bonded to a non-impregnable layer, *Landau* does not anticipate the claimed invention.

Assuming arguendo that the Examiner considers the foam layer to be a non-impregnable layer, *Landau* still does not disclose, teach, or suggest in any way a cover skin that is disposed over and bonded to the substrate, as required in claim 14. There is no support for this structure anywhere in the *Landau*. As previously stated, *Landau* clearly teaches that

the clear coat is applied to the foam layer. Because, *Landau* does not disclose, teach, or suggest a cover skin that is bonded to the substrate, *Landau* does not anticipate the claimed invention.

Landau also teaches a foam covered coil having a film laminate 36 in lieu of having a clear coat. Figures 2 and 3 clearly illustrate that the film laminate 36 is bonded to the foam layer 32 which is in turn bonded to metal coil 13. The Examiner stated in paragraph 6 of the Office Action that the film layer 36 corresponded with the claimed non-impregnable layer and the foam layer 32 corresponded with the claimed impregnable layer. Therefore, *Landau* teaches a cover skin that is bonded to an impregnable layer. This structure does not anticipate the claimed invention because it does not teach a cover skin that is bonded to a non-impregnable layer. Because *Landau* does not disclose a coverskin that is bonded to a non-impregnable layer, *Landau* does not anticipate the claimed invention.

Even if the foam layer 32 is considered to be a non-impregnable layer, *Landau* does not disclose, teach, or suggest in any way a cover skin that is disposed over and bonded to the substrate, as required in claim 14. As previously stated, this structure is completely absent from the *Landau* reference. *Landau* clearly teaches that the film layer 36 is laminated to the foam layer 32. In order to support a rejection under § 102, the Examiner must provide a reference that teaches each and every element of the claimed invention. Because, *Landau* does not disclose, teach, or suggest a cover skin that is bonded to a substrate, *Landau* does not anticipate the claimed invention.

Claims 36 and 42 depend from claim 14 and therefore are not anticipated by *Landau*. Because *Landau* does not disclose every element of claims 14, 36, and 42, the rejection is improper and must be withdrawn.

Claims 14, 36, and 42 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,514,458 to Schultze-Kadelbach *et al.* (*Schultze*). *Schultze* does not disclose every element of claim 14. For instance, *Schultze* does not disclose “a cover

skin disposed over and bonded to the first surface of the substrate.” (Emphasis Added). Assuming for the moment that the sealing layer 8 is a coverskin, the reference lacks any support for the proposition that the layer is in contact with the substrate, let alone bonded to it. Claims 36 and 42 depend from claim 14. Because *Schultze* does not disclose every element of any of claims 14, 36, and 42, the rejection is improper and must be withdrawn.

In view of the foregoing, Applicants respectfully assert that neither *Groendal*, *Landau*, and *Schultze* anticipates the claimed invention. Accordingly, Applicants respectfully request reconsideration and that the case pass to issue.

C. Claim Rejections Under 35 U.S.C. § 103

Claims 16 and 17 have been rejected under 35 U.S.C. 103(a) as being unpatentable over *Groendal* in view of *Fisher* (U.S. Patent No. 4,850,578).

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references must teach or suggest all of the claim limitations. MPEP 2143.03.

Claims 16 and 17 depend from independent claim 14 and include the limitations therein. Neither *Groendal* nor *Fisher*, nor the combination of the two teach or suggest each and every claim limitation of claim 14. As previously stated, *Groendal* does not disclose “a cover skin disposed over and bonded to the first surface of the substrate.” (Emphasis Added). *Fisher* does not provide the missing elements. *Fisher* discloses a method of manufacturing and cutting foam laminates. The disclosed laminates do not include either a coverskin or a substrate.

In order to make out a *prima facie* case of obviousness, the examiner must provide references that teach or suggest all of the elements of the claimed invention. The examiner has failed to establish a *prima facie* case of obviousness under § 103(a). Applicants

respectfully request that the Examiner withdraw the rejection of claims 16 and 17. In view of the foregoing, Applicants respectfully request reconsideration and that the case pass to issue.

D. Miscellaneous

Applicants have removed the limitation from claim 14 that the composite pad be "preformed." Applicants have added new claim 43 that depends from claim 14 and includes this limitation.

E. Conclusion

For the reasons stated above, Applicants respectfully submit that claims 14, 16-20 and 22-43 are allowable. Furthermore, claim 21 has been allowed and is currently pending.

Applicants have made a genuine effort to respond to each of Examiner's comments. Applicants submit that this entire application is now in condition for allowance and respectfully request a notice to that effect. If the Examiner believes that a further telephone conference will advance the prosecution of this application, such a conference is invited at the convenience of the Examiner.

Applicants have calculated no additional fee to be due in connection with the filing of this Paper. However, the Commissioner is hereby authorized to charge any fee deficiency incurred as a result of the filing of this Paper to our Deposit Account No. 02-3978 -- a duplicate of this paper is enclosed for that purpose.

Respectfully submitted,

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